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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/698,573

10/31/2003

Edward Alan Clark

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EXAMINER

NGUYEN, PHUOC H

ART UNIT

PAPER NUMBER

2143

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/698,573	<b>Applicant(s)</b> CLARK ET AL.	
	<b>Examiner</b> Phuoc H. Nguyen	<b>Art Unit</b> 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-21 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/31/03</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 18, and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1, 18, and 21 are Single Means Claims. A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor. See MPEP 2164.08(a).

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 recites "an article comprising computer-readable signal-bearing media" which contradicts each other as "an article" is an apparatus which does not comprise of "signal-bearing media". Appropriate clarification and/or correction are required.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims 1-17 appear to be software per se since the cited component(s) is considered as software module for performing the intended functions. As such, the claim is not limited to statutory subject matter and is therefore nonstatutory.

Claim 21 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claim 21, claims the non-statutory subject matter of a signal-bearing media. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1754 (claim to a data structure per se held nonstatutory). Therefore, since the claimed signal-bearing media are not tangibly embodied in a physical medium and encoded on a computer-readable medium then the Applicants has not complied with 35 U.S.C 101.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a) because they fail to show alphabetic components as described in the specification. For example, Fig. 1, element 105 should also label telephony device. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121 (d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

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of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-16, and 18-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Erev et al. (Hereafter, Erev) U.S. Pub. 2003/0084106.

Re claim 1, Erev discloses an apparatus, comprising an application server (e.g. streaming server) component that associates a data stream (e.g. reference of multimedia data) with a call through employment of an identifier (e.g. Universal Reference Identifier, URI) within a message associated with the call (e.g. page 5 paragraph 0084).

Re claim 2, Erev further discloses the application server component employs the identifier to establish the data stream (e.g. page 5 paragraph 0084 and page 6 paragraph 0087).

Re claim 3, Erev further discloses the application server component associates the identifier with the call through employment of the message (e.g. page 5 paragraph 0084 and page 6 paragraph 0087).

Re claim 4, Erev further discloses the application server component employs the identifier to associate one or more available services with the data stream, wherein the application server component employs the data stream to provide one or more services, of the one or more available services (e.g. page 5 paragraph 0094, and page 5 paragraphs 0098-0099).

Re claim 5, Erev further discloses the application server component associates the one or more services with the call through employment of the identifier (e.g. page 5 paragraph 0094, and page 5 paragraphs 0098-0099).

Re claim 6, Erev further discloses the application server component selects the identifier from a plurality of available identifiers, wherein the application server component associates the identifier with the call (e.g. page 5 paragraph 0094, and page 5 paragraphs 0098-0099).

Re claim 7, Erev further discloses the data stream comprises a first data stream, wherein the call comprises a first call, wherein the identifier comprises a first identifier of the plurality of available identifiers, wherein the application server component selects the first identifier and a second identifier from the plurality of available identifiers, wherein the application server component employs the second identifier to associate a second data stream with a second call (e.g. page 7 paragraphs 0097-0098).

Re claim 8, Erev further discloses upon termination of the data stream, the application server component returns the identifier to the plurality of available identifiers (e.g. page 7 paragraph 0095).

Re claim 9, Erev further discloses a switch component that cooperates with the application server component to associate the data stream with the call through employment of the identifier (e.g. Figure 2).

Re claim 10, Erev further discloses application server component provides the identifier to the switch component (e.g. Figure 2).

Re claim 11, Erev further discloses the switch component communicates with the application server component to obtain the identifier (e.g. page 6 paragraph 0090).

Re claim 12, Erev further discloses the application server component receives the identifier from the switch component (e.g. page 6 paragraph 0090).

Re claim 13, Erev further discloses the switch component communicates with the application server component to provide the identifier to the application server component (e.g. page 7 paragraph 0095).

Re claim 14, Erev further discloses the application server component employs the identifier to establish the data stream (e.g. page 5 paragraph 0084 and page 6 paragraph 0087).

Re claim 15, Erev further discloses the switch component cooperates with the application server component to provide one or more services of one or more available services through employment of the data stream (e.g. page 5 paragraph 0094, and page 5 paragraphs 0098-0099).

Re claim 16, Erev further discloses the switch component establishes the call, wherein the switch component cooperates with the application server component to update the call based on the one or more services (e.g. Figure 2; and page 5 paragraph 0094, and page 5 paragraphs 0098-0099).



Re claim 18 is method claim of claim 1; therefore claim 18 is also rejected under the same rationale as cited in the rejection of rejected claim 1.

Re claim 19, Erev further discloses the identifier comprises an address associated with an application server component, wherein the step of establishing the data stream associated with the call through employment of the identifier within the message associated with the call comprises the step of: establishing the data stream with the application server component through employment of the identifier (e.g. page 5 paragraph 0094, and page 5 paragraphs 0098-0099).

Re claim 20, Erev further discloses the message conforms to a first signaling protocol, wherein the data stream conforms to a second signaling protocol, wherein the step of establishing the data stream with the application server component through employment of the identifier within the message associated with the call, the method, comprising the steps of: establishing the call through employment of the message and establishing the data stream with the application server component through employment of the second signaling protocol (e.g. page 7 paragraph 0095 and page 8 paragraph 0106).

Re claim 21 is an article claim of claim 1; therefore claim 21 is also rejected under the same rationale as cited in the rejection of rejected claim 1.

#### ***Allowable Subject Matter***

6. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/698327. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are broader in scope than the claims of the copending Applications. Omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before. In re KARLSON (CCPA) 136 USPA 184 (1963).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Raz et al. U.S. Pub. No. 2001/0044850

Janik Craig M. U.S. Pat. 7,142,935

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuoc H. Nguyen whose telephone number is 571-272-3919. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Phuoc H Nguyen/  
Primary Examiner, Art Unit 2143

February 28, 2008